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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,802	10/31/2003	James D. Peterson	LUTZ 2 00228	2485
7590	10/05/2005		EXAMINER	
Richard J. Minnich, Esq. Fay, Sharpe, Fagan, Minnich & McKee, LLP Seventh Floor 1100 Superior Avenue Cleveland, OH 44114			TRAN, QUOC DUC	
			ART UNIT	PAPER NUMBER
			2643	

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/698,802

Applicant(s)

PETERSON, JAMES D.

Examiner

Quoc D. Tran

Art Unit

2643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

#### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 7-8, 9-10, 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farris et al (6,233,313) in view of Devine et al (2004/0008724).

Consider claim 1, Farris et al teach a method of conducting covert surveillance of a subject, said surveillance including surveillance of a monitored call connected over the network, said call being between the subject and an associate and including call progress data as well as circuit-switched or packet-switched call content comprising bearer traffic exchanged between the subject and the associate (see col. 4 line 45 – col. 6 line 55), said method comprising: (a) clandestinely receiving the circuit-switched call information (col. 8 line 58 – col. 9 line 6); and delivering the call information to a designated law enforcement agency (col. 9 lines 1-2).

Farris et al suggested providing call information to the CALEA in a protocol or format required by the agency (col. 5 lines 55-60). Farris et al did not suggest of providing call content and converting the received circuit-switched call content into a packet-switched format; and delivering the call content in the packet-switched format to a designated law enforcement agency

Art Unit: 2643

over a packet-switched data network. However, Devine et al suggested such (col. 2 ¶ 0007, 0013, 0015).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to incorporate the teaching of Devine et al onto view of Farris et al in order to provide data in digital form as well as reduce storage memory.

Consider claim 2, as discussed above, Farris et al teach wherein step (c) further comprises: transmitting the received call content to the law enforcement agency in substantially real-time while the monitored call is in progress (col. 21 lines 49-61).

Consider claim 3, as discussed above, Farris et al teach the method further comprising: storing the received call content prior to step (c) (col. 19 lines 40-43).

Consider claim 7, Farris et al teach the method further comprising: obtaining the call progress data; and, storing the call progress data (col. 19 lines 51-65; col. 21 lines 49-67).

Consider claim 8, Farris et al teach a system for conducting covert surveillance of a subject, said surveillance including surveillance of a monitored call connected over the network, said monitored call being between the subject and an associate and including circuit-switched or packet-switched call information comprising bearer traffic exchanged between the subject and the associate (see col. 4 line 45 – col. 6 line 55), said system comprising: monitoring means for clandestinely receiving the circuit-switched or packet-switched call information (col. 8 line 58 – col. 9 line 6); and, transmission means for delivering the call information to a designated law enforcement agency (col. 9 lines 1-2).

Farris et al suggested providing call information to the CALEA in a protocol or format required by the agency (col. 5 lines 55-60). Farris et al did not suggest of providing call content

Art Unit: 2643

and converting the received circuit-switched call content into a packet-switched format; and delivering the call content in the packet-switched format to a designated law enforcement agency over a packet-switched data network. However, Devine et al suggested such (col. 2 ¶ 0007, 0013, 0015).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to incorporate the teaching of Devine et al onto view of Farris et al in order to provide data in digital form as well as reduce storage memory.

Consider claim 9, as discussed above, Farris et al teach wherein the transmission means transmits the received call content to the law enforcement agency in substantially real-time while the monitored call is in progress (col. 21 lines 49-61).

Consider claim 10, as discussed above, Farris et al teach the system further comprising; storage means for storing the received call content prior to delivery by the transmission means (col. 19 lines 40-43).

Consider claim 13, Farris et al teach wherein the transmission means comprises a packet-switched data network (see Fig. 2, numeral 37).

Consider claim 15, Farris et al teach wherein the monitoring means comprises an application server complex implemented as an adjunct to a telecommunications switch providing service to the subscriber (col. 18 lines 28-38).

3. Claims 4-6 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farris et al (6,233,313) in view of Devine et al (2004/0008724) and in view of Nelkenbaum (6,751,297).

Consider claims 4 and 11, Farris et al did not suggest wherein step (c) further comprises: providing the law enforcement agency with access to the stored call content; and, transmitting the stored call content and call progress data to the law enforcement agency upon receipt of a request therefor from the law enforcement agency. However, Nelkenbaum suggested such (col. 14 lines 46-57; col. 16 lines 53-64). Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to incorporate the teaching of Nelkenbaum into view of Farris and Devine et al in order to provide on-demand capability.

Consider claims 5 and 12, Farris et al did not suggest the method further comprising: storing the received call content; and, providing the law enforcement agency with access to the stored call content; and step (c) further comprises both: (i) transmitting the received call content to the law enforcement agency in substantially real-time while the monitored call is in progress; and, (ii) transmitting the stored call content to the law enforcement agency upon receipt of a request therefor from the law enforcement agency. However, Nelkenbaum suggested such (col. 14 lines 46-57; col. 16 lines 53-64). Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to incorporate the teaching of Nelkenbaum into view of Farris and Devine et al in order to provide on-demand capability.

Consider claim 6, Farris et al did not suggest the method further comprising: applying data compression to the received call content in the packet-switched format. However, Nelkenbaum suggested such (col. 15 lines 55-62). Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to incorporate the teaching of Nelkenbaum into view of Farris and Devine et al in order to improve data transmission and storing.

Art Unit: 2643

4. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Farris et al (6,233,313) in view of Devine et al (2004/0008724) and further in view of Kouchri et al (2004/0219911).

Consider claim 14, Farris et al did not suggest wherein the translation means comprises a packet-switched gateway. However, Kouchri et al suggested such (page 2 ¶ 25). Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to incorporate the teaching of Kouchri et al into view of Farris and Devine et al in order transferring data over data network.

#### ***Response to Arguments***

5. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

7. Any response to this action should be mailed to:

Mail Stop \_\_\_\_ (explanation, e.g., Amendment or After-final, etc.)  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Facsimile responses should be faxed to:

**(571) 273-8300**

Hand-delivered responses should be brought to:  
Customer Service Window

Art Unit: 2643

Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Quoc Tran** whose telephone number is **(571) 272-7511**. The examiner can normally be reached on M, T, TH and Friday from 8:00 to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Curtis Kuntz**, can be reached on **(571) 272-7499**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Technology Center 2600** whose telephone number is **(571) 272-2600**.

**QUOCTRAN**  
**PRIMARY EXAMINER**

  
AU 2643

October 1, 2005